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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,242	02/01/2002	Andrew Richard Wainwright	294-107 PCT/US	9497

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EXAMINER

BECKER, DREW E

ART UNIT PAPER NUMBER

1761

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/936,242

Applicant(s)

WAINWRIGHT ET AL.

Examiner

Drew E. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on April 18, 2005 for an RCE based on parent Application No. 09/936,242 is acceptable and an RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al [Pat. No. 6,544,580] in view of de Vries [New Possibilities With Amylopectin Potato Starch].

Martines-Serna Villagran et al teaches a snack product comprising potato flakes (column 10, lines 15-28), the potato flakes comprising 78% of the snack product (column 21, line 25), cereal flours and normal potato starches (column 10, lines 40-63), additives such as emulsifiers (column 11, line 65), the snack products being fried, baked, or extruded (column 10, lines 15-28), Saturna variety of potatoes (column 4, line 28), less than 5% reducing sugars (column 11, line 50), and oil (column 17, line 30). Martines-Serna Villagran et al do not recite potato starch with an amylopectin content of at least 85%. De Vries teaches a snack product comprising potato starch with an

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amylopectin content of 100% (pages 2 & 9) which inherently would have been more expanded than starch with a normal amylopectin content. It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato starch of de Vries into the invention of Martines-Serna Villagran et al since both are directed to snack products, since Martines-Serna Villagran et al already taught a snack product made from potato and waxy corn starches (column 3, lines 50-64), since the high amylopectin potato starch of de Vries provided better viscosity compared to waxy corn starch (page 4), and since the 100% high amylopectin potato starch of de Vries combined high viscosity with high stability and high purity (page 6).

4. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al, in view of de Vries, as applied above, and further in view of Jeffcoat et al [Pat. No. 6,541,060].

Martines-Serna Villagran et al and de Vries teach the above mentioned components. Martines-Serna Villagran et al and de Vries do not recite less than 10% pregelatinized waxy potato starch. Jeffcoat et al teach a food product comprising less than 10% pregelatinized waxy potato starch (column 13, Example 18). It would have been obvious to one of ordinary skill in the art to incorporate the less than 10% pregelatinized waxy potato starch of Jeffcoat et al into the invention of Martines-Serna Villagran et al, in view of de Vries, since all are directed to food products, since Martines-Serna Villagran et al already included many different types of starches (column 10, lines 39-63), and since pregelatinized waxy potato starch was commonly used in food products, as shown by Jeffcoat et al (column 13, Example 18).

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5. Claims 1-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al in view of Tallberg et al [Pat. No. 5,824,798].

Martines-Serna Villagran et al teaches a snack product comprising potato flakes (column 10, lines 15-28), the potato flakes comprising 78% of the snack product (column 21, line 25), cereal flours and normal potato starches (column 10, lines 40-63), additives such as emulsifiers (column 11, line 65), the snack products being fried, baked, or extruded (column 10, lines 15-28), Saturna variety of potatoes (column 4, line 28), less than 5% reducing sugars (column 11, line 50), and oil (column 17, line 30).

Martines-Serna Villagran et al do not recite potato starch with an amylopectin content of at least 85%. Tallberg et al teaches a food product comprising potato starch with an amylopectin content of 100% (claim 1; column 1, lines 37-44) which inherently would have been more expanded than starch with a normal amylopectin content. It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potato starch of Tallberg et al into the invention of Martines-Serna Villagran et al since both are directed to food products, since Martines-Serna Villagran et al already taught a snack product made from potato starch and waxy corn starch which was high in amylopectin (column 3, lines 50-64), and since the 100% high amylopectin potato starch of Tallberg et al has not been subjected to chemical modification, making it more suitable as a food additive (column 1, lines 37-44).

6. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al, in view of Tallberg et al, as applied above, and further in view of Jeffcoat et al [Pat. No. 6,541,060].

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Martines-Serna Villagran et al and Tallberg et al teach the above mentioned components. Martines-Serna Villagran et al and Tallberg et al do not recite less than 10% pregelatinized waxy potato starch. Jeffcoat et al teach a food product comprising less than 10% pregelatinized waxy potato starch (column 13, Example 18). It would have been obvious to one of ordinary skill in the art to incorporate the less than 10% pregelatinized waxy potato starch of Jeffcoat et al into the invention of Martines-Serna Villagran et al, in view of Tallberg et al, since all are directed to food products, since Martines-Serna Villagran et al already included many different types of starches (column 10, lines 39-63), and since pregelatinized waxy potato starch was commonly used in food products, as shown by Jeffcoat et al (column 13, Example 18).

7. Claims 1-9 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al in view of Stahl [Pat. No. 5,759,597]

Martines-Serna Villagran et al teaches a snack product comprising potato flakes (column 10, lines 15-28), the potato flakes comprising 78% of the snack product (column 21, line 25), cereal flours and normal potato starches (column 10, lines 40-63), additives such as emulsifiers (column 11, line 65), the snack products being fried, baked, or extruded (column 10, lines 15-28), Saturna variety of potatoes (column 4, line 28), less than 5% reducing sugars (column 11, line 50), and oil (column 17, line 30).

Martines-Serna Villagran et al do not recite potato starch with an amylopectin content of at least 85%. Stahl teaches a food product comprising potato starch with an amylopectin content of at least 95% (claims 1-2) which inherently would have been more expanded than starch with a normal amylopectin content. It would have been

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obvious to one of ordinary skill in the art to incorporate the high amylopectin potato starch of Stahl into the invention of Martines-Serna Villagran et al since both are directed to food products, since Martines-Serna Villagran et al already taught a snack product made from potato starch and waxy corn starch which was high in amylopectin (column 3, lines 50-64), and since the high amylopectin potato starch of Stahl combined high viscosity with high stability and high purity.

8. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martines-Serna Villagran et al, in view of Stahl, as applied above, and further in view of Jeffcoat et al [Pat. No. 6,541,060].

Martines-Serna Villagran et al and Stahl teach the above mentioned components.

Martines-Serna Villagran et al and Stahl do not recite less than 10% pregelatinized waxy potato starch. Jeffcoat et al teach a food product comprising less than 10% pregelatinized waxy potato starch (column 13, Example 18). It would have been obvious to one of ordinary skill in the art to incorporate the less than 10% pregelatinized waxy potato starch of Jeffcoat et al into the invention of Martines-Serna Villagran et al, in view of Stahl, since all are directed to food products, since Martines-Serna Villagran et al already included many different types of starches (column 10, lines 39-63), and since pregelatinized waxy potato starch was commonly used in food products, as shown by Jeffcoat et al (column 13, Example 18).

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 0 799 837 A2 teaches a food product including high amylopectin potato starch.

### ***Response to Arguments***

10. Applicant's arguments filed April 18, 2005 have been fully considered but they are not persuasive.

Applicant argues that de Vries was directed to starch, rather than flakes and granules. However, de Vries teaches that this high amylopectin potato starch comes from a genetically altered potato. It therefore would have been obvious to one of ordinary skill in the art to use the potatoes of de Vries to make the flakes and granules of Martines-Serna Villagran et al in order to incorporate the high amylopectin starch.

Applicant argues that de Vries does not teach increased expansion as compared to normal amylopectin starch. Although de Vries states that there is "less expansion after frying" (page 9), this does not correlate to a lack of expansion as alleged by applicant. The phrase on page 9 of de Vries simply means that there is less expansion after frying, as compared to before or during frying. There is no mention of comparison to normal amylopectin starch. Therefore, since the combined teachings of Martines-Serna Villagran et al and de Vries used the same components as applicant, it would inherently possess the same properties, such as expansion.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Drew E Becker  
Primary Examiner  
Art Unit 1761

*Drew Becker*  
**DREW BECKER**  
**PRIMARY EXAMINER**  
*6-20-05*